

ESTTA Tracking number: **ESTTA365867**

Filing date: **08/31/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91183753
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Date	08/31/2010
Attachments	Defendant-s_Main_Brief.pdf (47 pages)(12205145 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HEAVEN HILL DISTILLERIES, INC)	
)	
Opposer,)	
)	Opposition No.91183753
V.)	
)	Serial No. 77/266,196
)	Mark HYPNOTIZER
)	
DIALLO YASSINN PATRICE,)	Intl Class: 033
)	
Respondent,)	

DEFENDANT'S MAIN BRIEF

Defendant's Yassinn Patrice DIALLO submits his Main Brief in answer to Opposer's Brief to Application serial Number 77266196 pursuant to 37 CFR 2.123(d) (a) (c).

INTRODUCTION

Defendant's Yassinn Patrice DIALLO respectfully requests the Trade Mark Trial and Appeal Board to reject the observations, arguments and elements sent by the Opposer in his Brief as they have no ground.

Defendant's, DIALLO YASSINN PATRICE a citizen of France, resident in 2 Square Tribord, 91080 Courcouronnes, France, denies that if his application serial N° 77266196 for the mark HYPNOTIZER is allowed to issue as a registration, it will harm Opposer HEAVEN HILL Distilleries inc, a Kentucky corporation with its principal place of business at 1064 Loretto Road, Bardstown, Kentucky, U.S.A 40004.

No likelihood of confusion, mistake or deception of purchasers or potential purchasers exists between the Opposer's claimed use of its HPNOTIQ Mark and the defendant's use of its trademark HYPNOTIZER because the marks are easily distinguishable in appearance, sound and meaning. Applicant seeks the registration for HYPNOTIZER for specific products as : Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines.

Heaven Hill's is the owner of the mark HPNOTIQ for liqueur, which is not famous, as opposed to what the Opposer affirms the other products of Heaven Hill are only candles, Liqueur, glassware and clothing with HPNOTIQ mark. The evidences show that Heaven Hill has no common law rights on unregistered mark, as cocktail invented HPNOTIZER, HYPNOTIZE, and others created deliberately and is in bad faith to attempt to appropriate the registered mark HYPNOTIZER, which belongs to Mr DIALLO YASSINN PATRICE. In fact the trade mark of Heaven HILL is **HPNOTIQ**.

The disputed proof in this case demonstrates that the use of HYPNOTIZER is only in connection with specific products as opposed to what the Opposer affirms: Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic

cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines, will not cause confusion and not mistake and not deceive consumers. Accordingly, the Trade Mark Trial and Appeal Board should accept the Diallo's application to register the HYPNOTIZER mark for specific products.

TABLE OF CONTENTS

INTRODUCTION.....	1
TABLE OF CONTENTS.....	4
INDEX OF CASES.....	5
DESCRIPTION OF THE RECORD.....	6
STATEMENT OF THE ISSUES.....	7
FACTS.....	8
ARGUMENTS.....	10
1. Differences between HPNOTIQ and HYPNOTIZER marks, from a visual, phonetic, intellectual point of view.....	11
2. Differences of products between HPNOTIQ and HYPNOTIZER marks.....	13
3. Lack of recognition of HPNOTIQ Marks.....	14
4. Incoherencies of the declarations of the deposition for Opposer of Justin Ames HPNOTIQ brand Manager, and Drew Wesley Account Manager.....	15
A. Relatedness of the Parties Goods.....	19
B. Differences of the Marks.....	20
C. Lack of evidence of confusion.....	21
D. Marketing Channels used.....	21
E. Likely Degree of Purchaser care.....	22
F. Intent of Opponent.....	22
G. Likelihood of expansion of products line.....	23
CONCLUSION.....	23

INDEX OF CASES

Cases

Palm Bay Imports INC. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Circ.2005).....	12
Lloyd's, 25 USPQ2d, at 2030; Old Tyme foods, 22 USPQ2d at 1545.....	13
Blue Man Productions INC. v Tarmann, 75 USPQ2d 1811, 1819 (TTAB 2005).....	14

Statutes

15 U.S.C. § 1052(d).....	11,13,14, 21, 24
37 C.F.R. § 2.123.....	1,6,10,15

DESCRIPTION OF THE RECORD

Again Defendant's Yassinn Patrice DIALLO, respectfully requests the Trade Mark Trial and Appeal Board to reject the observations, arguments and elements sent by the Opposer in his Brief as they have no ground. Moreover the evidences provided during the testimony period of the Opposer are not receivable for the following reasons:

37 CFR 2.123(d) Persons before whom depositions may be taken.

Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.

(a) Within the United States. Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.

(c) Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

For these reasons we request the TTAB to reject the testimony and the evidences and arguments provided during the testimony of Drew Wesley, Justin Ames and the direct examination made by Matthew Williams, as they are the public relation, employees and legal counsel of the Opposer Heaven Hill Distilleries. Moreover Yassinn Patrice DIALLO does not have evidence to invent, besides he is not right to question people who work and are paid by the Opposer (c) Disqualification for Interest.

Yassinn Patrice DIALLO provided evidences, which appear from the beginning of the procedure (see exhibits 1 to 7) and of others who are indisputable facts (see exhibits 8 to 11)

So the Board should give consideration to the allegations and exhibits given in this case.

STATEMENT OF THE ISSUES

The registration of HYPNOTIZER mark will not create likelihood of confusion in the marketplace because HYPNOTIZER is use in connection with specifics products as : Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholics malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktails, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines.

Each trade mark has a specific design, a different size and content (HPNOTIQ 70cl HYPNOTIZER 33cl) and a different mark and price.

Heaven Hill cannot seriously conclude that they own unregistered marks of cocktails such as HYPNOTIZE and HPNOTIZER. This is a non sense. In addition; Heaven Hill knew by its lawyer in France at the beginning of the year 2005 that Yassinn Patrice DIALLO had registered the mark HYPNOTIZER. They have therefore been able to elaborate a strategy to attempt to appropriate themselves a brand that does not belong to them.

FACTS

All the facts described by Heaven Hill are based on the testimonies of person who are a relative or employee or attorney or counsel of Heaven Hill , moreover each person is a relative or employee of such attorney or counsel, or is financially interested in the action therefore no declaration or proof is admissible. Thus all the declarations of Justin Ames, Norman Drew Wesley, or the direct examination of Matthew WILLIAMS are not receivable and also the evidences provided during theses testimonies.

Heaven Hill asserts that the consumers associate HPNOTIQ with the terms Hypnotic, spellbinding and mesmerizing, then why they do not claim them with the deposit of these terms and by registering them, but also with the terms hypnosis and hypnotism, this is a non legal sens.

Heaven Hill also asserts that their product is not only a liqueur but also is at the same time a vodka, a cognac and a fruit juice. But in their certificate registration it only refers to the term liqueur. Why does Heaven Hill not also claim the whisky, the wine, the tequila, the rum etc...? These statements are meaningless. The designs, packaging, bottles, products, and mark are different. Heaven Hill asserts to possess the brand HPNOTIZED, thanks to an advertising campaign. That shows a great sense of imagination but is in contrast with their registration certificate of HPNOTIQ. It clearly shows the desire to invent an argument without legal basis and bring discredit to Mr. DIALLO and his registration application for the mark HYPNOTIZER. Heaven Hill claims to have spent huge sums to publicize HPNOTIQ and make a well-known mark.

First as the TTAB states in their decision (TTAB decision in opposition N° 91165621) that the evidence is not sufficient to prove that HPNOTIQ is a famous mark. More over there is no evidence as to Opposer's advertising expenditure. The Opposer's didn't provide any

examples of its advertising or promotional materials to assist in determining the impact of the mark consumer.

HPNOTIQ mark uses conventional means used in the promotion of any products sold in mass consumption, such as other alcohols, and therefore has nothing of original. Moreover, the fact of claiming so-called brand names when it comes to cocktails invented, has no legal value, for example the cocktail named HPNO COLADA, etc..., this does not make Heaven Hill owner of the trademark or cocktail PINA COLADA.

Another example: the name of cocktail made with HPNOTIQ and MARTINI cannot make the Opposer the owner of HYPNOTIZE and MARTINI. This does not make sense. First because MARTINI does not belong to them and second because HPNOTIQ is not HYPNOTIZE, otherwise it means that Heaven Hill has the right to change their mark and registration as they see fit, which makes no sense. Moreover Heaven Hill also claims the name HPNOTIZER supposedly since May 2005 while their lawyer in France knew the registered trademark of Mr Patrice Diallo Yassinn since February 2005 (exhibit 8).

Heaven Hill claims to be using methods of non-traditional promotion, with disc jockeys, advertising, celebrities, bartenders and barmaids, these are common promotional methods used by other brands such as Skyy Vodka, Grey Goose Vodka, etc ... there is nothing original in this.

HPNOTIQ is supposedly intended to be used in cocktails before being used alone as a liqueur, but apparently Heaven Hill explains that their product is already a cocktail, which is used in other cocktails and for that they invent names of cocktails.

HYPNOTIZER is not intended to be mixed in a cocktail but to drink itself as such the alcohol content is about 5%. For example there are famous products in the United States namely "Bacardi Breezer" which is a ready to drink as such without being used in cocktails. The consumer cannot be induced in error indeed he is capable of knowing what he wants or does

not want to consume. We cannot decide for him and impose a product that he will pay, especially as alcohol products are intended for people over 21 years.

Finally all the facts described by Heaven Hill are based on the testimony of a person who are a relative or employee or attorney or counsel of Heaven Hill , or a relative or employee or attorney or counsel, or is financially interested in the action therefore any statement or evidence is not admissible. Thus all the declarations of Justin Ames, Norman Drew Wesley, or the direct examination of Matthew WILLIAMS are not receivable and also the evidences provided during theses testimonies. 37 CFR 2.123(d) Persons before whom depositions may be taken and (c) Disqualification for Interest: No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

ARGUMENTS

The decision of TTAB dated May 4 2006 states: "The office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2 (d), 15 U.S.C. 1052 (d). TMEP § 704.02." (exhibit 12).

Moreover after a letter of protest sent by the counsel of Heaven Hill (exhibit 13), the TTAB decide to reject the argument of the Opposer.

The respondent DIALLO YASSINN PATRICE never discusses the fact that HEAVEN HILL possesses all rights on HPNOTIQ mark, but he does not agree with the fact that HEAVEN HILL has the rights on HYPNOTIZER trade mark. The affirmations and the material facts of HEAVEN HILL in this case are in dispute.

We never discuss that HPNOTIQ belongs to HEAVEN HILL. But HEAVEN HILL admit in the Opposer's response to Respondent first set of request for admissions that HYPNOTIZER doesn't belong to them (exhibit 1).

On September 24 2007, HEAVEN HILL informed the Administrator of the Examiner's failure to identify HEAVEN HILL's mark due to an inadequate search performed during examination. The Administrator denied this protest and allowed publication of the mark HYPNOTIZER on April 8, 2008. (see letter of protestation of Heaven Hill Lawyer).

Wherefore, Applicant, DIALLO YASSINN PATRICE, respectfully requests that the opposition be dismissed with prejudice and his application Serial No. 77266196 be registered.

All the decisions mentioned by HEAVEN HILL concerning the case cited on this opposition are not cases similar to that one because HPNOTIQ is not a famous mark, see TTAB decision in opposition 91165621. And all the case cited concern famous mark.

1. Differences between HPNOTIQ and HYPNOTIZER marks, from a visual, phonetic, intellectual point of view.

Moreover, The US Trade Mark Office during office Record search for the Application HYPNOTIZER said: The Office Records have been searched and no similar registered or pending mark has been found that would bar registration under Trade Mark Act section 2 (d), 15 USC 1052 (d). The opponent can't use this argument and affirm in his ground on the Priority and likelihood of confusion Trademark Act section 2(d).

DIALLO Yassinn Patrice seeks registration for HYPNOTIZER mark, which is completely different in terms of products, mark, packaging, size, price (exhibit 2).

As HEAVEN HILL recognizes at the end on page 16 of Memorandum in Support of Opposer's Motion for Summary Judgment and Motion to suspend, « ...the different spellings and differences in phonetic pronunciation of the two marks.... » . For these reasons the consumers will not be confused.

Moreover HEAVEN HILL recognizes at the beginning of page 17: « ... there has not yet been evidence of actual confusion between goods bearing HPNOTIQ mark and those bearing HYPNOTIZER mark... », and affirms: « ...the lack of evidence of actual confusion at this point...»

HYPNOTIZER mark is not made for flavored sparkling water as the opponent lawyer try to affirm. The Opposer can clearly see that in October 2005 a registration certificate was delivered by French NIPO for HYPNOTIZER with a specific design (exhibit 3). In contrast to what the Opposer counsel intends to demonstrate, HYPNOTIZER application is for specific beverages including rum, as mentioned on the certificate design (exhibit 4). It is a clear evidence that we claim a special style, with a special bottle, and with colors and specific design, completely different from the opponent design (exhibit 5). It is a clear evidence that we apply for a specific mark and a specific design completely different to opponent mark and design and not only a mark as a word.

Again HEAVEN HILL conceded in his memorandum that there is no likelihood of confusion and that there is no evidence of actual confusion.

More over as the TTAB affirms, we must consider first the similarity or dissimilarity of the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports INC. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Circ.2005).

The TTAB decided in this opposition N° 99183753 mailed February 24, 2009 when the Opposer asks for a summary judgment and the Board denied it, that “The marks HYPNOTIZER and HPNOTIQ can be viewed as having different meanings and providing different commercial impressions”. See Lloyd’s, 25 USPQ2d, at 2030; Old Tyme foods, 22 USPQ2d at 1545. We can also see that the sound and the appearance of HYPNOTIZER are completely different from HPNOTIQ. The two Trade Marks would not be pronounced the same.

For these reasons Diallo’s application should be registered pursuant to 15 U.S.C § 1052(d).

2. Differences of products between HPNOTIQ and HYPNOTIZER marks.

No likelihood of confusion, mistake or deception of purchasers or potential purchasers exists between the Opposer’s claimed use of its HPNOTIQ Mark and the defendant’s use of its trademark HYPNOTIZER because the marks are used in connection with different products and beverages, and marketed to different classes of consumers.

As opposed to what the opposing party affirms, Respondent Diallo Yassinn Patrice doesn’t want to register the HYPNOTIZER mark for liqueur (exhibit 6), and as it is indicated on his Application form, the registration for HYPNOTIZER is filed for specifics products as : Alcoholic beverage produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcohols malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines.

Applicant denies the allegation of the opponent concerning the fact that the Applicant Diallo Yassinn Patrice wants to register the HYPNOTIZER mark in connection with liqueur because it is absolutely false. For these reason Diallo Yassinn Patrice application to register the HYPNOTIZER mark will not cause confusion, mistake, deception, or affiliation with HEAVEN HILL's HPNOTIQ mark for liqueur.

HPNOTIQ is used for a specific product the liqueur (exhibit 7), HYPNOTIZER is used for different products, there's no likelihood of confusion and moreover of dilution between the two Trade Marks. Diallo Yassinn Patrice's application should be registered pursuant to 15 U.S.C §§ 1052, 1063.

The law is clear in this case and the UPSTO decided to reject the argument of Heaven Hill because they considered that the trade mark HYPNOTIZER was not confusingly similar to the previously registered HPNOTIQ mark. The facts in this case are clear; the HYPNOTIZER mark is not confusingly similar to HEAVEN HILL's HPNOTIQ mark because the good listed in Diallo Yassinn Patrice application are different from liqueur, which does not appear in the products listed by Yassinn Patrice application for the HYPNOTIZER mark. Therefore, the TTAB should accept Diallo Yassinn Patrice application.

3. Lack of recognition of HPNOTIQ Marks.

HEAVEN HILL argues that HPNOTIQ is a famous mark. Yet, a previous decision by TTAB (TTAB decision in opposition N° 91165621) concluded that the evidence is not sufficient to prove that HPNOTIQ is a famous mark. In fact it is the duty of a plaintiff asserting that its mark is famous to clearly prove it, as the TTAB says. "Blue Man Productions INC. v Tarmann, 75 USPQ2d 1811, 1819 (TTAB 2005). The mark HPNOTIQ has been in use for a short period of time, six years. More over there is no evidence as to Opposer's advertising

expenditure. The Opposer's didn't provide any examples of its advertising or promotional materials to assist in determining the impact of the mark consumer.

4. Incoherencies of the declarations of the deposition for Opposer of Justin Ames HPNOTIQ brand Manager, and Drew Wesley Account Manager.

On the ground of Rule 28 of the Federal Rules of Civil Procedure 37 CFR 2.123 (d), Applicant request the TTAB to reject deposition made by Drew Wesley, Justin Ames and direct examination made by Matthew Williams. In fact, they are in conflict of interests in their depositions and direct examination, as they are employees and legal counsel of the Opposer Heaven Hill Distilleries.

37 CFR 2.123(d) Persons before whom depositions may be taken.

Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.

(a) Within the United States. Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.

(c) Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

On page 18 of his declaration, Norman Drew Wesley and Matthew Williams, the lawyer representing HEAVEN HILL, also employer of Norman Drew Wesley state that HEAVEN HILL employed the name HPNOTIZER for cocktails in a booklet for the promotion of HPNOTIQ product.

Yet, the Applicant filed the application for HYPNOTIZER trade mark in France on February 18th, 2005 and the Applicant's HYPNOTIZER trade mark was published on BOPI (French Bulletin Officiel de la Propriété Intellectuelle) (exhibit 8) on March 25th, 2005. In May 2005, the lawyer of HEAVEN HILL in France contacted the Applicant requesting that the Applicant abandon its trade mark HYPNOTIZER (exhibit 9).

Hence, this statement proves the lack of objectivity of Norman Drew Wesley's declaration as the Opposer knew about the existence of the Applicant's HYPNOTIZER trade mark at least since March 2005.

On page 7 of his testimony, line 24 to 25, Norman Drew Wesley states that HEAVEN HILL is his biggest client, and at the beginning of page 8 he states that he is in charge of all aspects of marketing and advertising of HPNOTIQ trade mark.

On page 18 of Norman Drew Wesley's testimony, line 16 to 21, he acknowledges that a booklet was edited on May 10th, 2005 with a particular recipe named HPNOTIZER. Hence, one can easily assume that Norman Drew Wesley was informed about the existence of the trade mark HYPNOTIZER in March 2005 and decided to create a cocktail that would be called HPNOTIZER.

All declarations on risk of confusion made starting from page 36 are pure speculations and prove their lack of independence due to their subordination to their biggest client, HEAVEN HILL Distilleries. The supposed risk of confusion mentioned on page 39 and 40 is a pure speculation with no ground. The declarations on page 41 on the positioning of HYPNOTIZER trade mark are incorrect, HYPNOTIZER is not targeting women.

Hence, all these declarations are driven by the financial interests of their author and cannot be taken into consideration as acceptable and admissible proof.

The declaration of Justin AMES is also subject to caution. Indeed, due to his subordination to his employer HEAVEN HILL, his statement is not independent from the Opposer.

Both Justin AMES and Matthew Williams the lawyer of the Opposer cannot be considered as objective due to their lack of independence. They cannot be judge and party.

On page 15, Justin AMES acknowledges that HPNOTIQ product is liquor. Hence, he cannot contradict the mention on the certificate of registration of HPNOTIQ showing that it is liquor and try to let believe that the product is something else. He also states that HPNOTIQ has 3 syllables while on the certificate it is written “HPNOTIQ”, hence two syllables, « HPNO » « TIQ ».

In page 16 of his declaration, he state that HPNOTIQ targets women, yet in page 17 he states that this product used to target the HIP HOP universe. Hence, the target of HPNOTIQ is not precisely defined.

On page 19 of his declaration, Justin Ames state that HEAVEN HILL protects its trade mark as follows: “We monitor other brands registration. We also use trade mark services. We look through magazines to see if other companies are producing or manufacturing any product that might use a similar name or confusingly similar name”.

This proves that when Applicant registered HYPNOTIZER trade mark in France, HEAVEN HILL was aware of Applicant’s HYPNOTIZER trade mark as soon as on March 25th, 2005 date of the publication of HYPNOTIZER in BOPI.

Page 21 and 22, Justin Ames acknowledges that HEAVEN HILL product is liquor and is sold on bottles of 750 ml. Again on page 25, Justin Ames mentions cocktails named HPNO-RITA and one other called HPNO-TIZER.

As Applicant has shown above, Justin Ames has discovered Applicant's HYPNOTIZER in March, and instead of opposing immediately to this mark, he took the time to build a strategy to create a link between HPNOTIQ and HYPNOTIZER by using "HPNO-RITA" "HPNO-TIZER" and "HPNOTIZE" in order to be able to build a case for opposing Applicant's trade mark, falsely claim ownership of HYPNOTIZER and risk of confusion with HPNOTIQ. The names HPNO-RITA" "HPNO-TIZER" and "HPNOTIZE" were therefore used by Opposer only after the publication of the Applicant's HYPNOTIZER trade mark, as a strategy and propaganda in order to falsely claim a stake in Applicant's HYPNOTIZER trade mark.

This appears in page 35 of the declaration saying "so the PR firm would have worked then to develop this name and the formulation for the drink". On page 66, he acknowledges that he knew about Applicant's HYPNOTIZER trade mark at the beginning of 2005, to the question: « when did you first become aware of Mr Diallo's intent to use the Hypnotizer mark in connection with alcoholic beverages ? » he answers : "Early 2005" which means as soon as March 2005.

On page 67, Opposer incorrectly states that he won the case in France against the registration of HYPNOTIZER for alcoholic beverages. This is not accurate as Applicant owns the trade mark HYPNOTIZER in France. As you may see (exhibit 10), Opposer requested Applicant not to market his products where HPNOTIQ is present. This request is illegal and has no ground.

On page 68, Opposer claims having a decision preventing Mr. Diallo from using HYPNOTIZER trade mark for alcoholic beverages in France and United Kingdom.

Yet the case in United Kingdom is not closed as Applicant has filed for alcoholic beverages and is pending decision (exhibit 11). Hence the Opposer claim is not accurate.

He recognizes on page 72 that currently there is no risk of confusion between HYPNOTIZER and HPNOTIQ. In addition, HEAVEN HILL lawyer has not brought any proof of risk of confusion as of October 20th, 2009 in spite of its denied request for a Summary Judgment

and a period for expert disclosure. No proof was given whereas Opposer was seeking declarations from experts.

On page 72, Justin Ames answers to the question of HEAVEN HILL lawyer: "And has HEAVEN HILL conducted any surveys to establish that consumers are likely to be confused by Mr Diallo's proposed use of the Hypnotizer mark in connection with alcoholic beverages ? ", " No conducting a reliable survey is an expensive proposition, and we didn't think it was necessary because there is a high degree of similarity between Hypnotizer and Hpnotiq."

Yet, in spite of the additional period of 7 month granted for expert disclosure, Opposer has not been able to provide any proof of risk of confusion.

The counsel of HEAVEN HILL is familiar with this proceeding as specialist law firm. He is supposed to know the laws and the rules as a specialist in the intellectual property.

The TTAB did mention the following before granting additional time to Opposer **"It has been six months since Opposer originally filed its motion for an extension of time. The Board presumes that Opposer has made good use of its time since then to mitigate the issue of not having "sufficient time to complete discovery and prepare for trial."**

Yet, Opposer used additional time just to delay the trial without bringing any proof.

A. Relatedness of the Parties Goods

In fact M DIALLO Yassinn Patrice seeks to register HYPNOTIZER mark in connection with specifics beverages products as : Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcohols malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines. HPNOTIQ is registered for liqueur only (see certificate exhibit 7), the

declarations with regards to invented cocktails and supposed unregistered marks are a complete non sense, they have no registration, no certificate, and they have been especially created to claim the mark of Mr Yassinn Patrice Diallo. Moreover they have created a cocktail called “**HPNOTIQ SUB-ZERO MARTINI**” why not also claim the Martini brand. All this shows bad faith. The cases cited have nothing to do with this case and involve notorious marks : " *Daddy' s Junky Music Stores, Inc. v. Big Daddy' s Family Music Center*, 109 F.3d 275, 280, 42 U.S.P.Q.2d 1173 (6th Cir. 1997); *accord In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q 563 (C.C.P.A 1973); *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1116 (6th Cir. 1996); *Daddy's Junky Music Stores*, 109 F.3d at 280; *TCIP Holding Co. v. Haar Communications*, 244 F.3d 88, 100, 57 U.S.P.Q.2d 1969 (2d Cir. 2001); *See Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147, 67 U.S.P.Q.2d 1420 (2d Cir. 2003); *Virgin Enters. Ltd.*, 335 F.3d at 148.

B. Differences of the Marks

All the cases cited by the Heaven Hill concern cases that have nothing to do with the present case and are notorious brands. " *Educational Testing Serv. v. Touchstone*, 739 F. Supp. 847, 850, 16 U.S.P.Q.2d 1865 (S.D.N.Y. 1990). *See, e.g., David 26 Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377 (8th Cir. 1965) (finding SARNOFF for vodka to be confusingly similar to SMIRNOFF also for vodka); *Brown-Forman Distillery Co. v. Arthur M. Bloch Liquor Importers, Inc.*, 99 F.2d 708 (7th Cir. 1938) (finding OLD FOSTER for whiskey to be confusingly similar to OLD FORESTER also for whiskey); *Jules Berman*, 202 U.S.P.Q. 67 (T.T.A.B. 1979) (finding CHULA for coffee-flavored liqueur to be confusingly similar to KAHLUA also for coffee-flavored liqueur); *Beck & Co. v. Package Distribs. Of America, Inc.*, 198 U.S.P.Q. 573 (T.T.A.B. 1978) (finding EX BIER for beer to be confusingly similar to BECK'S BEER also for beer).

Moreover the marks HYPNOTIZER and HPNOTIQ are completely different and easily distinguishable in terms of phonetic, meaning, design, name, product, size and packaging.

Again the cases cited here concern famous marks and have no relation with this present case. *See Standard Oil Co. v. Standard Oil Co.*, 252 F.2d 65, 116 U.S.P.Q. 176 (10th Cir. 1958); *see also Faberge, Inc. v. Madison Shirt Corp.*, 192 U.S.P.Q. 223 (T.T.A.B. 1976). Linking the name of a cocktail invented by Heaven Hill "HPNOTIZER", to create purposely confusion with HYPNOTIZER owned by Mr DIALLO Yassinn Patrice is again a non sense.

C. Lack of evidence of confusion

Heaven Hill recognizes that there is no evidence of actual confusion and add that there is a lack of actual confusion, however, has no bearing on whether Diallo's HYPNOTIZER mark poses a likelihood of confusion with Heaven Hill's HPNOTIQ registered mark and its unregistered HPNOTIZER, HYPNOTIZE, and HPNO marks: this statement has no meaning because HPNOTIQ is different of HYPNOTIZER (see TTAB examination search) The TTAB decide in a letter dated May 4, 2006 : The office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2 (d), 15 U.S.C. 1052 (d). TMEP § 704.02. (exhibit 12). Moreover the affirmations of invented cocktail names, which would be unregistered marks, are nonsense.

HEAVEN HILL currently recognizes "Due to the difficulty of securing evidence of actual confusion, a lack of such evidence....." and adds "Thus, the lack of evidence of actual confusion at this point is not significant". Again the case cited here ." *Daddys Junky Music Stores*, 109 F.3d at 284, has no relation with the case and concern famous marks. If there is no evidence of likelihood of confusion it is not necessary to invent some.

D. Marketing Channels used.

Again Heaven Hill affirms they would have the right to decide what products could use some distribution channels in the U.S., until proven otherwise the trade in the U.S. is certainly regulated but free. It is not forbidden to sell drinks when you are in compliance with laws and regulations of the United States of America. The cases cited here once again have nothing to

do with this present case and involve notorious marks. *Champions Golf Club*, 78 F.3d at 1120, *See In re Elbaum*, 211 U.S.P.Q. 639, 640 (T.T.A.B. 1981); accord *The NASDAQ Stock Market, Inc.*, 69 U.S.P.Q.2d 1718, 1732 (T.T.A.B. 2003)

E. Likely Degree of Purchaser care.

Again in this paragraph the cases cited have nothing to do with this case and involve notorious marks *Daddys Junky Music*, 109 F.3d at 285 *Frisch's Restaurants, Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir. 1982), *See Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 1074, 12 U.S.P.Q.2d 1901, 1904 (Fed. Cir. 1989). Heaven Hill is trying to make us believe that because they sell in small quantities as a promotional item, a bottle in a 20cl format, the client would be unable to differentiate between the two products HYPNOTIZER and HPNOTIQ, from the point of view of phonetic, meaning, design, name, product, size and packaging. Moreover they come again on the legal nonsense of invented cocktail names, which would be unregistered trademark.

F. Intent of Opponent

Heaven Hill cannot deny that HYPNOTIZER mark belongs to Mr DIALLO Yassinn Patrice and that the strategy he develops in order to claim a different brand of theirs for different products with differences in phonetic, meaning, design, name, product, size and packaging. Seeing that Mr DIALLO Yassinn Patrice was not a legal expert they decided to intimidate with large legal cabinets thinking that this person without means and legal knowledge would give up his property and rights. All the cases cited again here are cases involving famous marks and have nothing to do with the present case *See Daddy's Junky Music Stores*, 109 F.3d at 286 *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910); *see also Stork Rest. v. Sahati*, 166 F.2d 348, 361 (9th Cir. 1948), *John Walker & Sons, Ltd. v. Bethea*,

305 F. Supp. 1302, 1310 (D.S.C. 1969). Heaven Hill is trying to take possession of a mark that does not belong to them.

G. Likelihood of expansion of products line.

Again Heaven Hill forgets that Mr DIALLO Yassinn Patrice has registered the trademark HYPNOTIZER for specific products such as : Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcohols malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines. Heaven Hill have registered the trademark HPNOTIQ for liqueur only and affirm: « but if there were any doubts, these doubts must be resolved in favor of Heaven Hill based on cases that have no connection with this present case and involve notorious marks him.” *Interstate Brands Corp. and Interstate Brands West Corp. v. McKee Foods Corp.*, 53 U.S.P.Q.2d 1910, 1915 (T.T.A.B. 2000), J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23.65 (4th ed. rel. 40 12/2006) (citing *State Historical Soc. v. Ringling Bros. Barnum & Bailey Combined Shows, Inc.*, 190 U.S.P.Q. 25 (T.T.A.B. 1976))... Heaven Hill have made every effort to intimidate Mr DIALLO Yassinn Patrice with large legal cabinets (Exhibit 9), and appropriate the HYPNOTIZER mark, a mark already registered by him and wanting to deprive him of his rights and his property.

CONCLUSION

DIALLO Yassinn Patrice HYPNOTIZER mark is completely different from HPNOTIQ mark and the affirmations of invented cocktails names that are unregistered trademarks is a legal nonsense. Moreover HYPNOTIZER mark intends to use with specific products. As The TTAB has decided in a letter dated May 4 2006: “The office records have been searched and

no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2 (d), 15 U.S.C. 1052 (d) “.

For these reasons Diallo’s application should be registered pursuant to 15 U.S.C § 1052(d) and HEAVEN HILL opposition denied.

Respectfully submitted

DIALLO YASSINN PATRICE

PROOF OF SERVICE

I hereby certify that a true and correct copy of Defendant's Main Brief was served on the following attorney for Opposer by deposit in the French Mail, in Paris France, in a sealed envelope, with first class postage fully prepaid this 30 August, 2010.

Matthew A. Williams

Wyatt Tarrant & Combs, LLP

500 West Jefferson Street, Suite 2800

Louisville, KY 40202

UNITED STATES.

502-562-7378 Telephone

Dated : August 30, 2010

DIALLO YASSINN PATRICE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HEAVEN HILL DISTILLERIES, INC.,)		
)		
Opposer,)	Opposition No.	91183753
)		
v.)		
)	Serial No.	77/266,196
DIALLO YASSINN PATRICE,)	Mark:	HYPNOTIZER
)	Intl Class:	033
Respondent.)		

**OPPOSER'S RESPONSE TO RESPONDENT'S FIRST SET OF
REQUEST FOR ADMISSIONS**

1. Please identify the Person(s) answering these interrogatories.

RESPONSE: Opposer objects to Request for Admission No. 1 because it fails to propound a statement to be admitted or denied. Without waiving the prior objection, undersigned counsel for Opposer Heaven Hill, Inc. have prepared these Responses to Respondent's Requests for Admissions.

2. Please admit that you want to steal the trademark HYPNOTIZER who belong to YASSINN PATRICE DIALLO, in order to use it for your profit.

RESPONSE: Denied.

3. Please admit that your product HPNOTIQ is used only in connection with one specific product the liqueur.

RESPONSE: Denied.

4. Please admit that the trade mark HYPNOTIZER is a trademark who belong to M DIALLO YASSINN PATRICE.

RESPONSE: Denied.

5. Please admit that the trademark HYPNOTIZER is not a trademark who belong to Heaven Hill Distilleries.

RESPONSE: Admitted.

EXHIBIT
31183753
1-DEFENDANT'S
Heaven Hill v Diallo

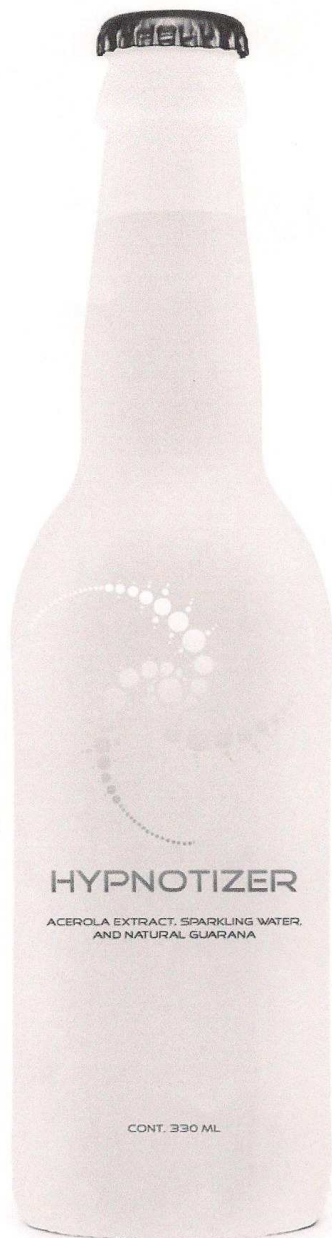


EXHIBIT
31183753
2- DEFENDANTS
Heaven Hill V DiAllo



DESSINS ET MODÈLES

Code de la propriété intellectuelle
Livres IV : (Titre premier), V et VIII

NOTIFICATION DE PUBLICATION ET CERTIFICAT D'IDENTITÉ

Le dépôt de dessin(s) ou modèle(s) dont les références et la(les) reproduction(s) figurent au verso a été publié au Bulletin officiel de la propriété industrielle n° **05/21 du 21 octobre 2005**

La présente notification vaut certificat d'identité.

Le Directeur général de l'Institut
national de la propriété industrielle

Benoît BATTISTELLI

INSTITUT
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S1183753
3- DEFENDANT'S
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DIALLO Yassinn
2 square Tribord
91080 COURCOURONNES

- (21) N°(s) d'enregistrement ou national : 05 0903
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Nombre total de dessins ou modèles : 2
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91080 COURCOURONNES
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Modèle(s) publié(s)

- (51) Classement
09-03 (11) N°(s) de publication
765 152 et 765 153
(54) Nature du (des) objet(s) : Emballage, Emballage et sa
capsule
D.M. n° 1 et 2 : 1 repr.
(45) Date de publication : 21 octobre 2005
(57) Description : Repr. 1-1 : Vue dépliée. ♦ Repr. 2-1 : Embal-
lage et sa capsule



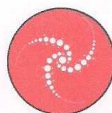
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765 152

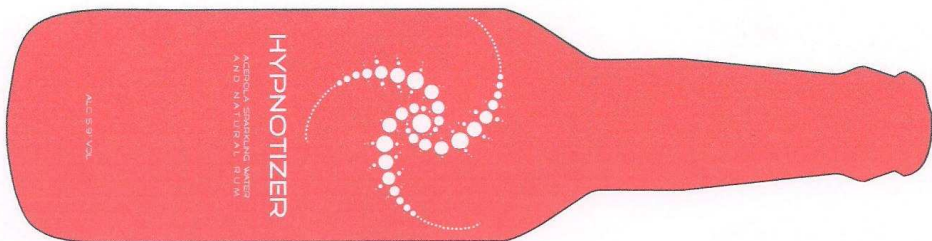


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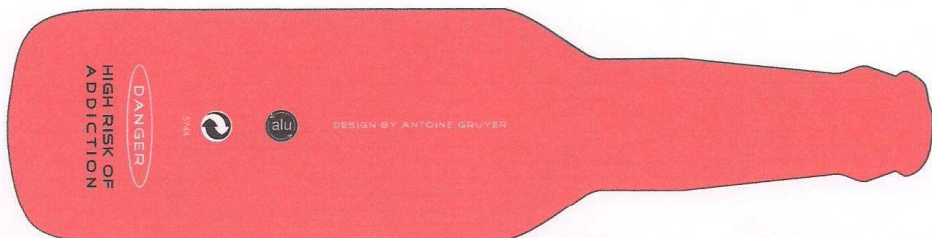
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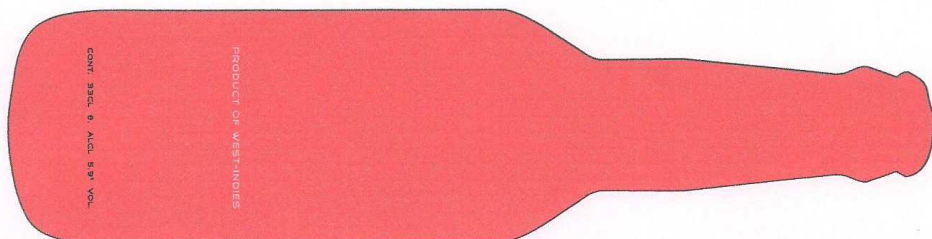
CAPSULE



FRONT



SIDE



BACK

EXHIBIT
51183713
4 - DEFENDANT'S
Heaven Hill V DiMaio



EXHIBIT
51183753
5- DEFENDANT'S
Heaven Hill Vodka



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HYPNOTIZER

Word Mark HYPNOTIZER

Goods and Services IC 033. US 047 049. G & S: Alcoholic beverage produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard cider, Natural sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, wines

Standard
Characters
Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77266196

Filing Date August 28, 2007

Current Filing
Basis 1B

Original Filing
Basis 1B

Published for
Opposition April 8, 2008

Owner (APPLICANT) DIALLO YASSINN PATRICE INDIVIDUAL FRANCE 2 SQUARE TRIBORD
COURCOURONNES FRANCE 91080

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead
Indicator LIVE

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18/04/2010

EXHIBIT
91183753
G- DEFENDANT'S
HARRIS HILL V DIALLO

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

United States Patent and Trademark Office

Reg. No. 2,642,855

Registered Oct. 29, 2002

**TRADEMARK
PRINCIPAL REGISTER**

HPNOTIQ

GLOBAL PERSPECTIVES, INC. (NEW YORK
CORPORATION)
108-50 62ND DRIVE
FOREST HILLS, QUEENS, NY 11375

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

SER. NO. 76-372,289, FILED 2-20-2002.

FOR: LIQUEUR, IN CLASS 33 (U.S. CLS. 47 AND
49).

YSA DEJESUS, EXAMINING ATTORNEY

EXHIBIT
S1183753
7 - DEFENDANT'S
Heaven Hill V DiAllo

de location d'enregistrements sonores, d'appareils audio, de bande vidéo, de caméras vidéo; montage de bandes vidéo; montage de programmes radiophoniques; montage de programmes de télévision; enregistrement (filmage) sur bande vidéo; publication d'information en matière de mise à jour de bases de données; services d'enregistrement, de reproduction de données, de sons et d'images; services de location d'appareils pour l'enregistrement, la reproduction de données, de sons et d'images.

Classes de produits ou services : 9, 16, 35, 36, 38, 41.

N° National : 05 3 342 166

Dépôt du : 18 FEVRIER 2005

à : I.N.P.I. PARIS

M DIALLO YASSINN PATRICE, 2 SQUARE TRIBORD, 91080 COURCOURONNES.

Mandataire ou destinataire de la correspondance :
M DIALLO YASSINN, 2 SQUARE TRIBORD, 91080 COURCOURONNES.

HYPNOTIZER

Produits ou services désignés : Bières; eaux minérales. Boissons alcooliques; vins; spiritueux.

Classes de produits ou services : 32, 33.

N° National : 05 3 342 167

Dépôt du : 18 FEVRIER 2005

à : I.N.P.I. PARIS

CONFEDERATION NATIONALE DU CREDIT MUTUEL, association régie par la loi du 1er juillet 1901, 88-90, rue Cardinet, 75017 PARIS.

Mandataire ou destinataire de la correspondance :
ERNEST GUTMANN, YVES PLASSERAUD, S.A., 3 rue Chauveau-Lagarde, 75008 PARIS.

DOMI +

Produits ou services désignés : Matériels, équipements et dispositifs électroniques pour la télématique, l'informatique, la bureautique, la monétique; appareils automatiques déclenchés par l'introduction d'une pièce de monnaie, d'un jeton ou d'une carte bancaire, distributeurs automatiques de billets; cartes bancaires; cartes à puce notamment cartes à mémoire, ou à micro-processeur ou magnétique ou à puce comportant un crédit d'unités, notamment d'unités téléphoniques; cartes téléphoniques; supports d'enregistrement magnétiques, numériques et optiques, cédérom, vidéodisques; appareils pour l'enregistrement, la transmission, la reproduction du son ou des images; équipement pour le traitement de l'information et les ordinateurs; téléphones, téléphones mobiles; assistant personnel (ordinateur), ordinateurs, ordinateurs portables, lecteur MP3; puces électroniques; cartes SIM; logiciels, notamment logiciels pour le traitement de l'information, logiciels de jeux, appareils pour jeux conçus pour être utilisés seulement avec récepteur de télévision; jeux automatiques (machines) à préparation. Cartes en papier; cartes en carton; produits de l'imprimerie; bulletins et imprimés d'abonnements téléphoniques, d'abonnements à un service de radiotéléphonie, d'abonnements à un service radiomessagerie, d'abonnements télématiques, d'abonnements à une base de données, d'abonnements à un serveur de bases de données, d'abonnement à un centre fournisseur d'accès à un réseau informatique ou de transmission de données, notamment de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet), d'abonnements à des journaux électroniques, d'abonnements à un service de télécommunication; livres; revues; magazines; journaux; dépliant en papier, prospectus en papier, affiches, calendriers, autocollants, imprimés publicitaires,

formulaires; papeterie; matières plastiques pour l'emballage à savoir, sacs, sachets, films et feuilles. Publicité, services de location d'espaces publicitaires. Services d'abonnements téléphoniques, abonnements à un service de radiotéléphonie, abonnements à un service radiomessagerie; abonnements télématiques, abonnements à une base de données, abonnements à un serveur de bases de données, abonnement à un centre fournisseur d'accès à un réseau informatique ou de transmission de données, notamment de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet); abonnements à des journaux électroniques; abonnements à des services de télécommunication. Consultations professionnelles d'affaires. Conseils, informations ou renseignements d'affaires dans les secteurs bancaire, financier, monétaire et boursier; consultations et informations dans le domaine de l'épargne; analyses, estimations, informations et prévisions économiques; renseignements économiques, statistiques et commerciaux sur les marchés financiers, monétaires et boursiers accessibles notamment par voies télématiques, par réseaux informatiques, par réseaux Internet, Intranet et Extranet; gestion de fichiers, de bases et de banques de données informatiques, d'annuaires professionnels électroniques dans les secteurs bancaire, financier, monétaire et boursier; gestion administrative de produits financiers, de portefeuilles de titres en bourse, gestion administrative de portefeuilles sous mandat; établissement de relevés de comptes, vérification de comptes. Assurances; affaires financières; affaires monétaires; affaires bancaires; affaires immobilières; gestion de comptes bancaires; gérance de portefeuille; services de cartes de crédit; courtage en assurance, courtage en bourse; estimations financières (assurances, banques, immobilier), estimations et expertises fiscales; recouvrement de créances; émissions de chèques de voyage et de lettres de crédit; services financiers, bancaires, monétaires et boursiers accessibles par réseaux téléphoniques, par réseaux de communications informatiques; réception, exécution et transmission d'ordres pour le compte de tiers (émetteurs et investisseurs) sur un ou plusieurs instruments financiers; gestion financière de portefeuilles sous mandat, gestion financière d'actifs pour le compte de tiers; analyse financière des marchés de taux, de change et d'actions; services d'informations et de conseils sur les produits financiers; services d'informations et de conseils en investissements et en placements financiers; services d'investissements et de placements financiers; agences de change, dépôts de valeurs, dépôts en coffres-forts; gérance de fortunes; crédit, prêts sur gage, prêt sur nantissement, crédit-bail; épargne; gestion de patrimoines mobiliers ou immobiliers; gestion de portefeuilles de titres en bourse; services de cartes de débit et de cartes de crédit; opérations et transactions sur les marchés financiers; émission d'emprunts indexés sur actions, émission d'obligations indexées sur actions et indices financiers et boursiers; informations bancaires, financières et monétaires accessibles notamment par voies télématiques, par réseaux informatiques, par réseaux Internet, Intranet et Extranet. Télécommunication, services téléphoniques, services de diffusion, de transmission d'informations par voie télématique; services de fourniture d'accès à des centres serveurs nationaux et internationaux; services de fourniture d'accès à un réseau téléphonique, radiotéléphonique, de communication mondiale; services de diffusion, de transmission d'informations par voie télématique; transmission de télégramme; transmission par satellite; transmission de messages; transmission et diffusion de données, de sons et d'images; transmission d'informations accessibles via des bases de données et via des centres serveurs de bases de données informatiques ou télématiques; services de fourniture de temps d'accès à des bases de données et à des centres serveurs de bases de données informatiques ou télématiques notamment pour les réseaux de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet); transmissions d'informations par code d'accès à des bases de données et à des centres serveurs de bases de données informatiques ou télématiques; service de courrier électronique, de messagerie électronique, et de diffusion d'informations par voie électronique, notamment pour les réseaux de communication mondiale (de type Internet) ou à accès privé ou réservé (de type Intranet); service de fourniture de temps d'accès à des réseaux téléphoniques, radiotéléphonique, télématiques; services de transmission sécurisée de données, de sons ou d'images; services de location d'appareils pour la transmission de données, de sons et d'images, location d'appareils pour la transmission de messages; location d'appareils et de postes téléphoniques et radiotéléphoniques, location de récepteurs, d'émetteurs téléphoniques et radiotéléphoniques; location, services d'informations en matière de télécommunications; transmission par télécommunication d'informations contenu de radiodiffusion; service de télématique. Divertissements, information, d'éducation; organisation et conduite de colloques, de réunion et conduite de concours (éducation et conduite d'épreuve).

EXHIBIT
3183753
8 - DEFENDANTS
Heaven Hill U.D.I.A.L.G.

Alger
Belgrade
Bruxelles
Bucarest
Budapest
Casablanca
Hanoi
Istanbul
Londres



Gide Loyrette Nouel

Moscou
New York
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Tunis
Varsovie

Grégoire Triet
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Tél. +33 (0)1 40 75 61 51
Fax +33 (0)1 40 75 37 01
triet@gide.com

Monsieur M Diallo Yassinn Patrice
2, square Tribord
91 080 Courcouronnes

Paris, le 11 mai 2005

Lettre recommandée avec accusé de réception

Réf. : Dépôt de la marque verbale Hypnotizer n° 05 3 342 166

Monsieur,

Je suis le conseil de la société américaine Heaven Hill Distilleries, Inc., dont le siège social est situé 1064 Loretto Road – 40 004 Bardstown – Etats-Unis.

1. La société Heaven Hill Distilleries, Inc. est titulaire des marques suivantes :

- marque française verbale "HPNOTIQ" enregistrée le 24 janvier 2002 sous le numéro 3 143 392 pour désigner les produits suivants en classe 33 : "liqueurs" ;
- marque communautaire verbale "HPNOTIQ" déposée le 18 mars 2002 et enregistrée le 30 juin 2003 sous le numéro 2 620 466 pour désigner les produits suivants en classe 33 : "liqueurs" ;
- marque communautaire figurative déposée le 23 décembre 2002 et enregistrée le 8 mars 2004 sous le numéro 2 989 085 pour désigner les produits suivants en classe 33 : "liqueurs".

Les droits dont dispose la société Heaven Hill Distilleries, Inc. sur les signes précités lui confère un monopole absolu sur l'usage de ces signes et la faculté de s'opposer à tout dépôt et

ASSOCIATION D'AVOCATS À LA COUR DE PARIS

26, cours Albert 1^{er} 75008 Paris Tél. +33 (0)1 40 75 60 00 Fax +33 (0)1 43 5

E-mail info@gide.com www.gide.com

EXHIBIT
51183753
3- DEFENDANT'S
Heaven Hill V Diallo

usage de ceux-ci ou d'un signe similaire pour des produits ou services identiques ou similaires à ceux désignés par ces enregistrements.

2. Or, la société Heaven Hill Distilleries, Inc. a eu la surprise de constater que vous aviez procédé au dépôt, auprès de l'INPI, le 15 février 2005, de la demande d'enregistrement du signe "Hypnotizer" pour désigner les produits et services suivants des classes 32 et 33 : *"Bières, eaux minérales, boissons alcooliques, vins, spiritueux"*.

3. Le signe que vous avez déposé est similaire à ceux qui ont été enregistrés par la société Heaven Hill Distilleries, Inc. et désigne des produits identiques ou à tout le moins similaires aux produits désignés par les marques de la société Heaven Hill Distilleries, Inc.

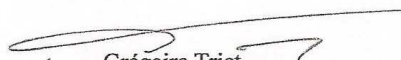
En conséquence, la société Heaven Hill Distilleries, Inc. considère que votre dépôt de marque porte atteinte à ses droits au sens de l'article L. 711-4 du Code de la propriété intellectuelle et est susceptible de constituer un acte de contrefaçon au sens de l'article L. 713-3 du même code.

4. **C'est pourquoi, la société Heaven Hill Distilleries, Inc. vous demande de bien vouloir procéder au retrait total de votre demande de marque n° 05 3 342 166.**

A défaut d'avoir reçu, **au plus tard le 18 mai prochain**, une réponse satisfaisante de votre part et la justification du retrait total de votre demande, la société Heaven Hill Distilleries, Inc. m'a d'ores et déjà chargé de former opposition à l'encontre de son enregistrement.

Je suis bien entendu à la disposition de celui de mes confrères auquel vous souhaiteriez confier la défense de vos intérêts pour m'entretenir de ce dossier avec lui.

Je vous prie de croire, Monsieur, à l'assurance de ma considération distinguée.


Grégoire Triet
Avocat à la Cour



500 West Jefferson Street, Suite 2800
Louisville, Kentucky 40202-2898
502.589.5235
502.589.0309

Matthew A. Williams
502.562.7378
mwilliams@wyattfirm.com

September 10, 2009

CONFIRMATION COPY

via EMAIL: yassin.diallo@laposte.net
Confirmation via FedEx

Yassinn Patrice Diallo
2 Square Tribord
COURCOURONNES 91080
FRANCE

Re: **US Opposition No. 91183753**
UK Opposition No. 95763

Dear Mr. Diallo:

Enclosed with this letter is a copy of the decision the UK Trademark Registry recently issued in the favor of Heaven Hill Distilleries, Inc. ("Heaven Hill") that was forwarded to me by Heaven Hill's counsel in the UK, David Potter.

As I am sure you are aware from your own review of the decision, the Registry found in no uncertain terms that your proposed use of the HYPNOTIZER mark in connection with alcoholic beverages, spirits, and wines would create a likelihood of confusion in the marketplace. The Registry quite justifiably based this decision on the high degree of distinctiveness of Heaven Hill's HPNOTIQ mark when used with liqueurs, the high degree of similarity between the HPNOTIQ and HYPNOTIZER marks, and the identical or related nature of the parties' respective goods.

This now makes two countries that have properly concluded that your proposed use of the mark HYPNOTIZER in connection with alcoholic beverages would create a likelihood of confusion with Heaven Hill's use of its senior HPNOTIQ mark in connection with liqueur. Hopefully, you will now concede that Heaven Hill's rights in its HPNOTIQ mark simply preclude you from using or registering the HYPNOTIZER mark in connection with alcoholic beverages.

EXHIBIT
91183753
10-DEFENDANT'S
Heaven Hill v. Diallo

LOUISVILLE KY LEXINGTON KY BOWLING GREEN KY NEW ALBANY TN NASHVILLE TN MEMPHIS TN

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Yassinn Patrice Diallo
September 10, 2009
Page 2

We further note that the UK Registry's decision requires you to pay a contribution of £1,550 toward Heaven Hill's costs in prosecuting the opposition. Heaven Hill would, however, be willing to forego collection of these costs if you would agree to (1) not appeal the Registry's decision in the UK; (2) voluntarily abandon your U.S. application to register the HYPNOTIZER mark, Serial No. 77/266,196; and (3) undertake to not use the HYPNOTIZER mark in any country where Heaven Hill has registered its HPNOTIQ mark or where Heaven Hill sells its HPNOTIQ goods.

Should these terms be acceptable to you, please sign and return the enclosed copy of this letter acknowledging your acceptance of these terms along with documentation demonstrating that you have filed to voluntarily abandon U.S. Application Serial No. 77/266,196.

If, on the other hand, you proceed with appealing the UK decision, you should be aware that Heaven Hill will vigorously defend against such an appeal and seek a further award of costs to cover the costs it incurs in contesting the appeal of a well-reasoned decision by the Registry.

Please feel free to contact me if you would like to discuss any of these matters in further detail.

Very truly yours,

WYATT, TARRANT & COMBS, LLP

Matthew A. Williams

MAW/dkl

Enclosure

cc: David A. Calhoun, Esq. (via email)
David Potter, Esq. (via email)

20318862.2

**AGREED TO, ACCEPTED, AND
RECEIPT ACKNOWLEDGED BY:**

Yassinn Patrice Diallo

Date

SIGN
HERE

Diallo Yassinn Patrice
2 Square Tribord Courcouronnes
91080
France

Concept House

Cardiff Road, Newport
South Wales, NP10 8QQ
United Kingdom

Switchboard: +44(0)1633 814000
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DX: 722542 Cleppa Park 3

Website: www.ipa.gov.uk

Tel: +44(0)1633 811116
Fax: +44(0)1633 817777
O/Ref: 2462677/Team D/SMACR
Y/Ref: 873089
Date: 18 October 2007

Please quote our reference when replying.

Dear Sir or Madam,

Application No: 2462677 in Class 33
For the Mark: HYPNOTIZER
Applicant: Diallo Yassinn Patrice

EXAMINATION OF TRADE MARK APPLICATION

I have examined your application and carried out a search of earlier national trade marks and Community and International trade marks which cover the UK.

The requirements for registration appear to be met so the application is accepted. We will now publish it in the Trade Marks Journal on our website for opposition purposes. We will tell you the Journal number and date of publication shortly.

After the mark has been published, there is a three month period in which anybody may oppose its registration. If we receive any such opposition, we will write to tell you.

If nobody opposes the mark, we will automatically register it three weeks after the end of the opposition period and send you the registration certificate soon afterwards.

Yours faithfully,



Mrs S J Macrory
Trade Marks Examiner

EXHIBIT
31183753
M - DEFENDANT'S
Heaven Hill v DIALLO

Search criteria:

Target Nice classes:

33

Cross search list Nice classes:

32, 33, 34, 35

Case statuses:

New Application
Examined
Awaiting advert
Advertised
Opposition outstanding
Removed from Journal
To be readvertised
Late objection raised
Progress Delayed
Ready for registration
Registered
Protected
Expired
Surrendered
Withdrawn
Refused
Revoked
Deemed abandoned
Abandoned
Invalid

Word Search Terms:

hypnotizer, hypnotiser, hypnotize, hypnotise, hypnotizers, hypnotizes

Word Mark types:

Word Only
Word and Device
Stylised Word Mark
Form (Shape) and Word
Miscellaneous Word

Dates:

From 01.01.1876 to 30.07.2007

Marked Hits:

Case number:

Case status:

Case number:

Case status:

Word Hits:

* M873089 *Precedent* OPPOSED

M734514

PRTCTD

END OF REPORT

See attached print



Case details for International Madrid(UK) Trade Mark M873089

[Explanation of terms](#) used on this page

Mark

HYPNOTIZER

Mark text: HYPNOTIZER

Status

UK case status: Opposition outstanding

Classes: 33, 32

Relevant dates

Date of international registration: 07 October 2005

Date of designation in UK: 07 October 2005

Next renewal date: 07 October 2015

Office of origin details

Office of origin: France

Office of origin reference: GM

Basic application or registration number Filing or registration date
053342166 07 October 2005

Publication in Trade Marks Journal

First advert: Journal: 6628

Publication date: 07 April 2006

List of goods or services

Class 33: Alcoholic beverages, wines, spirits.

Class 32: Beers.

Names and addresses

Holder: DIALLO YASSINN PATRICE
2, square Tribord, F-91080
COURCOURONNES, France

UK service: M Diallo Yassinn Patrice C/o Willy Bozor
14 Abbey Court, 20 MacLeod Street, London,
United Kingdom, SE17 3HA

Earlier rights notification

Opted in for notifications

[Explanation of terms](#) used on this page

The "M" prefix is used purely within the UK and is not part of the Madrid(UK) registration number.

This enquiry shows information from the International Registration held by us. If you want to see details of the definitive International Registration, please visit the [World Intellectual Property Organization](#).



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Intellectual Property Office is an operating name of the Patent Office

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/019547

APPLICANT: DIALLO YASSINN PATRICE

CORRESPONDENT ADDRESS:

DIALLO YASSINN PATRICE
2, square Tribord
F-91080 COURCOURONNES FRANCE

MAY 4 2006



RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: HYPNOTIZER

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and email address.

RE: Serial Number 79/019547

EXAMINER'S AMENDMENT

OFFICE RECORDS SEARCH: The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

ADVISORY – AMENDMENTS TO GOODS/SERVICES: If the identification of goods and/or services has been amended below, any future amendments must be in accordance with 37 C.F.R. §2.71(a) and TMEP §1402.07(e).

AMENDMENT(S) AUTHORIZED: *If applicant disagrees with or objects to any of the amendments below, please notify the undersigned trademark examining attorney immediately.* Otherwise, no response is necessary. TMEP §707.

The trademark examining attorney is amending the application as follows. No prior approval or authorization from applicant or applicant's attorney is required. TMEP §707.02.

IDENTIFICATION OF GOODS

Due to some grammatical mistake in that the identification needs to separate the goods through the use of commas, the identification of goods is amended to read as follows:

EXHIBIT
SM83753
12 - DEFENDANTS
HEAVEN HILL V DIALLO

International Class 033: Alcoholic beverage produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard cider, Natural sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wine, Tequila, Vodka, Whiskey, Wine coolers, Wines

TMEP §1402.01(e).

/Alain Lapter/
Trademark Attorney
Law Office 108 - 5D29
571-272-8607 (phone)
571-273-8607 (official fax)
alain.lapter@uspto.gov



500 West Jefferson Street, Suite 2800
Louisville, Kentucky 40202-2898
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Matthew A. Williams
502.562.7378
mwilliams@wyattfirm.com

September 24, 2007

Letter of Protest

ATTN: Trademark Administrator
United States Patent & Trademark Office
600 Dulany Street MDE-4B89
Alexandria, VA 22314-5793

Re: Letter of Protest
Application Serial No.: 77/266,196
Filing Date: August 28, 2007
Mark: HYPNOTIZER
Int'l Class: 33

Dear Sir or Madam:

This Letter of Protest is submitted against the application of Yassini Patrice Diallo ("Diallo") to register HYPNOTIZER for use in International Class 33 with various alcoholic beverages, Serial No. 77/266,196, on behalf of Heaven Hill Distilleries, Inc. ("Heaven Hill"). A copy of the TARR printout for Diallo's application is enclosed as Exhibit A.

Heaven Hill is the owner of the U.S. Trademark Registrations listed below for the mark HPNOTIQ (copies of the registration certificates are enclosed as Exhibit B).

Mark	Registration No.	Goods	First use of mark in commerce
HPNOTIQ	2642855	Liqueur, in IC 033	September, 2001
HPNOTIQ	2822475	Liqueur, in IC 033	September, 2001
HQOPN (amp; bottle design)			
HPNOTIQ	2834133	Candles, in IC 004	May 2, 2003
		Beverage glassware, in IC 021	March 23, 2003
HPNOTIQ	2834130	Clothing, namely shirts, in IC 025	February 7, 2003

LOUISVILLE, KY LEXINGTON, KY BOWLING GREEN, KY NEW ALBANY, IN NASHVILLE, TN MEMPHIS, TN FORT COLLINS, CO JACKSON, MS

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EXHIBIT
51183713
13- DEFENDANT'S
Heaven HILL V Diallo



Letter of Protest
September 24, 2007
Page 2

Heaven Hill believes that its registrations provide prima facie evidence supporting a refusal of registration on the basis of a likelihood of confusion because two of its registrations are for alcoholic beverages in International Class 33 and because of the similarity of the marks. See TMEP § 1715. Therefore, Heaven Hill's Letter of Protest should be granted.

As further background, Heaven Hill notes that this is Diallo's second attempt to register HYPNOTIZER in international class 33 for the same goods. His first attempt, Application Serial No. 79/019,547, was a 66A application that was cancelled after his underlying French registration was cancelled for all alcoholic beverages. The TARR and TESS printouts for this application are attached hereto as Exhibit C.

This cancellation occurred as a result of an opposition prosecuted by Heaven Hill in France. The decision of the Court of Appeals of Paris, and an English translation thereof, upholding the finding of the French Industrial Property Office that HYPNOTIZER, when used in connection with alcoholic beverages and beer, created a likelihood of confusion with Heaven Hill's HPNOTIQ mark is attached as Exhibit D. Before this cancellation occurred, Heaven Hill had actively opposed Application Serial No. 79/019,547 in Opposition No. 91173767.

While the conclusions of the French Industrial Property Office and the French Court's are not dispositive, they certainly support Heaven Hill's position that its registrations for HPNOTIQ in connection with liqueur present prima facie evidence supporting a refusal to register Diallo's HYPNOTIZER mark on the basis of a likelihood of confusion.

Moreover, the prosecution history in Serial No. 79/019,547 demonstrates that the Examining Attorney may not independently identify Heaven Hill's registrations despite the similarity of the marks and the goods. This is illustrated by the summary of the XSearch performed during the examination of Serial No. 79/019,547, which is attached as Exhibit E. A review of this summary reveals that the search did not identify any marks having a "h" followed directly by a "p" as it occurs in Heaven Hill's HPNOTIQ mark. Rather, as illustrated by the inquiries in lines 01 and 02, the search methodology only identified marks having an "i," "y," or "e" between an "h" and a "p." Similarly, the inquiry in line 03 did not identify Heaven Hill's HPNOTIQ registrations because it identifies only marks having a "t" followed by an "i," "e," or "y" followed by a "c," "s," or "z." The remaining inquiries, lines 04-07, are simply combinations of 01-03 or inquiries 01, 02, or 03



Letter of Protest
September 24, 2007
Page 3

with an additional limitation. Thus, the search failed to identify Heaven Hill's HPNOTIQ registrations.

Rather than forcing it to wait until Diallo's new application is published for opposition and forcing it to again endure the burden of prosecuting an opposition, Heaven Hill respectfully requests that its Letter of Protest be granted. This will ensure that the Examining Attorney has the opportunity to consider the likelihood of confusion that Diallo's applied for mark creates with Heaven Hill's pre-existing registrations.

If we can provide you with any additional information to assist you in deciding to grant this Letter of Protest, please do not hesitate in calling me at 502-562-7378.

Very truly yours,

WYATT, TARRANT & COMBS, LLP

A handwritten signature in black ink, appearing to read "Matthew A. Williams".
Matthew A. Williams

MAW/dkl

Enclosures

cc: Mr. Max L. Shapira
William H. Hollander, Esq.
(both w/out encls.)

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